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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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IBM CORPORATION (RHF) C/O ROBERT H. FRANTZ P. O. BOX 23324 OKLAHOMA CITY, OK 73123			EXAMINER SHIH, HAOSHIAN	
			ART UNIT 2173	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/692,173	<b>Applicant(s)</b> CHEN ET AL.	
	<b>Examiner</b> HAOSHIAN SHIH	<b>Art Unit</b> 2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20090716</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1- 18 are pending in this application and have been examined in response to application RCE filed on 05/08/2009.
2. Claims 16-18 are new.
3. The indicated allowability of claims 1-15 are withdrawn in view of applicant's amendment.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-5, 6-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
6. Claim 1 and 6 recites: "concatenating...into a clipboard in memory" There is no mention in the original specification of having concatenating information elements into a clipboard. Thus, the limitation includes subject matter that was not described in the

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original specification. Further, in accordance with application spec. [0078], [0079], the concatenated information elements are stored in a transfer buffer.

7. If the examiner has overlooked the portion of the original specification that describes the feature of the present invention, then applicant should point it out (by page number and line number) in the response to this office action.

Applicant may obviate this rejection by canceling the claim.

8. Claims 2-5 and 7-10 are rejected similarly.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claims 16 and 17 recites the limitation "said buffer". There is insufficient antecedent basis for this limitation in the claim.

12. Claims 1-15 are rejected similarly.

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13. Claim 18 recites the limitation "a transfer buffer" in line 10 and "said buffer" in line 12. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. **Claims 16-18 are rejected under 35 U.S.C. 102(b) as being unpatentable by Apperley et al. (Apperley, "Breaking the copy/paste cycle: the stretchable selection tool").**

16. As to **INDEPENDENT** claim 16, Apperley discloses a computer-implemented method comprising: providing a copier configured to allow a user to designate a destination point or area in a first computer resource, and to select in a second user interface to a second computer resource two or more information elements in said second computer resources (sect. 3.1, par.2; a destination area/sink field and source area/tank fields are visually connected allowing for a destination first, source second copy/paste operation);

Responsive to said user selection, automatically concatenating said selected information element into a transfer buffer (fig.3; sect. 3.1, par.1, sect. 3.3, par.7, lines 7-

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9); information elements are copied to a clipboard as the user drags the stretchable selection tool across information items 64 - 9 - 366 0212); and

Automatically transferring said information items from said buffer, to said destination point or area of one or more information elements (fig.3; sect. 3.1, par.1; information items 64 - 9 - 366 0212 on the right, are identified and copied to the "Fax" field on the left).

17. As to **INDEPENDENT** claim 17, see rationale addressed in the rejection of claim 16 above.

18. As to **INDEPENDENT** claim 18, see rationale addressed in the rejection of claim 16 above.

### ***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**20. Claims 1, 6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable by Apperley in view of Stern et al. (Stern, US 6,807,668 B2).**

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21. As to claim 1, Apperley discloses wherein said providing of a copier comprises providing a destination-first, source-second element copier configured to allow a user in a first user interface to a first computer resource to designate a destination point or area in said first computer resource, and to subsequently select in a second user interface to a second computer resource two or more information elements in said second computer resource (fig.3; sect. 3.1, par.2; a destination area/sink field and source area/tank fields are visually connected allowing for a destination first, source second copy/paste operation of multiple information elements such as “6” and “4” in fig.3);

Wherein said concatenating further comprises, subsequent to said user selections, automatically copying said selected information elements into a clipboard in memory (fig.3; sect. 3.1, par.1; sect.3.3, par.7; information items 64 - 9 - 366 0212 on the right, are identified, stored in a clipboard and copied to the “Fax” field on the left);

Apperley does not disclose wherein said automatic transferring further comprises, upon attempt to automatically transfer said information items from said transfer buffer, intercepting the transfer to said destination point or area of one or more information elements; and said method further comprising: performing a compatibility check for each intercepted information element with the destination computer resource by consulting one or more user-configurable compatibility rules to classify elements as incompatible or compatible; for each incompatible element, performing a compatibility handling action as defined by one or more conversion rules; and for each compatible element, allowing transfer of the unmodified compatible element to the destination.

In the same field of endeavor, Stern discloses wherein said automatic transferring further comprises, upon attempt to automatically transfer said information items from said transfer buffer, intercepting the transfer to said destination point or area of one or more information elements (col.7, lines 25-30; a drag manager checks the capabilities of the information elements before issuing a paste command);

said method further comprising: performing a compatibility check for each intercepted information element with the destination computer resource by consulting one or more user-configurable compatibility rules to classify elements as incompatible or compatible (col.45, lines 6-9, lines 31-34; “GetFlavorFlags” determines compatibility, “GetFlavorData” determines data type, user uses the data returned from the functions described above to configure compatibility rules);

for each incompatible element, performing a compatibility handling action as defined by one or more conversion rules (col.9, lines 40-57; “translation manager”); and

for each compatible element, allowing transfer of the unmodified compatible element to the destination (col.7, lines 60-64; col.9, lines 36-40).

It would have been obvious to one of ordinary skill in the art, having the teaching of Apperley and Stern before him at the time the invention was made, to modify the destination first, source second copy/paste interface taught by Apperley to include an element compatibility manager taught by Stern with the motivation being to copy potentially incompatible information elements to a destination area (Stern, col.8, lines 15-3; col.9, lines 49-55).



22. As to claim 6, see rationale addressed in the rejection of claim 1 above.

23. As to claim 11, see rationale addressed in the rejection of claim 1 above.

**24. Claims 2-5, 7-10 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Apperley, Stern, Tomm et al. (Tomm, US 6,560,608 B1) and in view of Tsuji et al. (Tsuji, US 5,586,025).**

25. As to claim 2, Apperley and Stern do not disclose invoking a rule management user interface responsive to finding no existing compatibility rule for an element to be transferred; allowing, via said rule management user interface, a user action selected from the list of creating a new compatibility rule, deleting a compatibility rule, and modifying a compatibility rule.

In the same field of processing data, Tomm discloses a system for selecting rules to process data. Tomm further teaches invoking a rule management interface ("rule editor") responsive to finding no existing rule for matching for an element to be transferred (fig.6; "630", "640", "650"); Tomm also teaches allowing, via said rule management user interface, a user action to create a new rule (see col.5, lines 35-41).

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It would have been obvious to one of ordinary skill in the art, having the teaching of Apperley and Stern and the teaching of Tomm before him at the time the invention was made, to modify the system for transferring content taught by Apperley and Stern to include an interface for adding new rules taught by Tomm with the motivation being to enhance the usefulness of Apperley and Stern's system since the added new rules "are available for subsequent [compatibility checking] operations" (see Tomm, col.7, lines 61-62).

Tomm does not disclose deleting a compatibility rule, and modifying a compatibility rule.

In the same field of endeavor, Tsuji discloses a rule management user interface (fig.1, "17"), a user action selected from the list of creating a new rule (col.5, lines 65-66, "registration of a new rule"), deleting a rule (col.6, lines 11-12 "delete the rule base"), and modifying a rule (col.5, lines 67- col.6, lines 2, "changing a stored rule).

It would have been obvious to one of ordinary skill in the art, having the teaching of Apperley, Stern and Tomm, and the teaching of Tsuji before him at the time the invention was made, to modify system for transferring content taught by Apperley, Stern and Tomm to include the rule deletion and modification taught by Tsuji with the motivation being to provide a customizable user interface for rules manipulation.

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26. As to claim 3, Apperley and Stern does not disclose invoking a rule management user interface responsive to finding no existing conversion rule for an element to be transferred; and allowing, via said rule management user interface, a user action selected from the list of creating a new conversion rule, deleting a conversion rule, and modifying a conversion rule.

In the same field of processing data, Tomm discloses a system for selecting rules to process data. Tomm further teaches invoking a rule management interface ("rule editor") responsive to finding no existing rule for matching for an element to be transferred (fig.6; "630", "640", "650"); Tomm also teaches allowing, via said rule management user interface, a user action to create a new rule (see col.5, lines 35-41).

It would have been obvious to one of ordinary skill in the art, having the teaching of Apperley and Stern and the teaching of Tomm before him at the time the invention was made, to modify the system for transferring content taught by Apperley and Stern to include an interface for adding new rules taught by Tomm with the motivation being to enhance the usefulness of Apperley and Stern's system since the added new rules "are available for subsequent [compatibility checking] operations" (see Tomm, col.7, lines 61-62).

Tomm does not disclose deleting a compatibility rule, and modifying a conversion rule.

In the same field of endeavor, Tsuji discloses a rule management user interface (fig.1, "17"), a user action selected from the list of creating a new rule (col.5, lines 65-66,

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“registration of a new rule”), deleting a rule (col.6, lines 11-12 “delete the rule base”), and modifying a rule (col.5, lines 67- col.6, lines 2, “changing a stored rule”).

It would have been obvious to one of ordinary skill in the art, having the teaching of Apperley, Stern and Tamm, and the teaching of Tsuji before him at the time the invention was made, to modify system for transferring content taught by Apperley, Stern and Tamm to include the rule deletion and modification taught by Tsuji with the motivation being to provide a customizable user interface for rules manipulation.

27. As to claim 4, Stern discloses creating and modifying a conversion rule which specifies performing an action selected from a group comprising converting a text element from one format to another format, converting a graphic image element from one format to another format, converting a video clip element from one format to another format, converting an audio clip element from one format to another format, converting animated image element from one format to another format, isolating an element, isolating an element and transferring an annotation to said destination, isolating an element and transferring a hyperlinked annotation to said destination (col.65, lines 4-8; each compatible format (col.7, lines 26-30 defines flavors as different data types, it is consistent with the definition of data format) is listed via the translation manager (col.9, lines 49-54))

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28. As to claim 5, Stern discloses performing a compatibility handling action comprises performing an action selected from the list of converting a text element from one format to another format, converting a graphic image element from one format to another format, converting a video clip element from one format to another format, converting an audio clip element from one format to another format, converting animated image element from one format to another format isolating an element, isolating an element and transferring an annotation to said destination, isolating an element and transferring a hyperlinked annotation to said destination (col.65, lines 4-8; each compatible format, (col.7, lines 26-30 defines flavors as different data types, it is consist with the definition of data format) is listed via the translation manager (col.9, lines 49-54)).

29. As to claim 7, see rationale addressed in the rejection of claim 2 above.

30. As to claim 8, see rationale addressed in the rejection of claim 3 above.

31. As to claim 9, see rationale addressed in the rejection of claim 4 above.

32. As to claim 10, see rationale addressed in the rejection of claim 5 above.

33. As to claim 13, see rationale addressed in the rejection of claim 3 above.

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34. As to claim 14, see rationale addressed in the rejection of claim 4 above.

35. As to claim 15, see rationale addressed in the rejection of claim 5 above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAOSHIAN SHIH whose telephone number is (571)270-1257. The examiner can normally be reached on m-f 0730-1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kieu Vu can be reached on (571) 272-4057. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tadesse Hailu/  
Primary Examiner, Art Unit 2173

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